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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,987	09/12/2003	Fumiya Ohmi	62301-Z CCD	6094
7590 Christopher C. Dunham c/o Cooper & Dunham LLP 1185 Ave. of the Americas New York, NY 10036	06/28/2007		EXAMINER PSITOS, ARISTOTELIS M	
			ART UNIT 2627	PAPER NUMBER
			MAIL DATE 06/28/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/660,987	OHMI, FUMIYA	
	<b>Examiner</b>	<b>Art Unit</b>	
	Aristotelis M. Psitos	2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 16 March 2007.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 9-12 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 9-12 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892) ✓
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

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## **DETAILED ACTION**

Applicant's response of 65/16/07 has been considered with the following results.

### ***Information Disclosure Statement***

The IDS of 5/21/07 has been received and entered. The noted JP OAs have not been considered since this examiner has not reviewed them – i.e., not in English.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

1. Claims 9 and 10 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claim 9 fail(s) to correspond in scope with that which applicant(s) regard as the invention can be found in the reply filed 5/16/07 In that paper, applicant has stated

“ A recording power for formatting is determined by multiplying the recording power for recording data by a coefficient of 1 or less, and the recording power for formatting is utilized to format the medium. Independent claims 9 and 11 address these features,... ”.

and this statement indicates that the invention is different from what is defined in the claim(s) because the above noted multiplying by a coefficient of 1 or less is not found in claim 9.

However, if it were to be included in claim 9, then claims 9 and 11 would be substantially duplicate claims and hence the examiner would require canceling one of these claims.

As far as the claims recite positive limitations, the following positions are taken.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Muramatsu et al.

The following analysis is made:

Claim 9

Muramatsu et al

A method for formatting an optical information recording medium, comprising the steps of:  
performing a power calibration by a drive,  
determining a first recording power to be used for recording data, utilizing a result of the power calibration,

See title/abstract

see discussion with respect to the PCA  
in the first region (PCA 2)

inherent – see fig. 7 for instance

at step 42

and

formatting the medium by said drive at a second recording power for formatting which is equal to or lower than the first recording power for recording data determined as the result of the power calibration.

see step[ step 44 plus in fig. 7

In the above analysis, as disclosed in Muramatsu et al, in a first region, the pca is determined. Subsequently, for further formatting/writing of information onto the disc, this optimum value is further relied upon and used with the appropriate relationship as discussed with respect to figure 3, see col. 4 starting at line 53 till col. 5 line 29 for instance.

Hence, the examiner concludes that the above method limitations are met.

With respect to claim 10, since this is interpreted as a product by process claim, and the above process has been met, the product falls as well.

#### ***Response to Arguments***

Applicant's arguments with respect to claims 9 and 10 have been considered but are moot in view of the new ground(s) of rejection.

3. Claims 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 11-045440.

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Applicant's attention is drawn to the accompanying MAT (Machine assisted translation of the JP document).

The JP document, as discussed in the abstract, executes an OPC in a first area. This meets the First step in claim 9. With respect to the second and third steps, see the remainder of the abstract, as well as the MAT starting at paragraph 10.

With respect to claim 10, since this is interpreted as a product by process claim, and the above process has been met, the product falls as well.

***Response to Arguments***

Applicant's arguments with respect to claims 9 and 10 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Muramatsu et al, or by JP 11-045440 each further considered by either Nakao et al or Kubota et al.

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Claim 11 differs from claim 9, in that it further defines the second step as,

" ... by multiplying the first recording; power by a coefficient of 1 or less, ... ".

As further noted by either the Kubota et al or the Nakao et al documents, when performing the appropriate rerecording step/writing (which the examiner interprets as the claimed formatting", appropriate values are used by

a) In Kubota et al, again reference is made to the disclosure starting with the 9<sup>th</sup> embodiment.

b) see in Nakao et al starting at col. 5 line 45 with respect to the description of figure 3.

It would have been obvious to modify the base system of either Muramatsu et al or JP 11-045440 with the above additional teachings from either secondary reference in order to use appropriate mathematical operations, such as multiplication by an appropriate coefficient value in order to yield a final power level as required.

With respect to claim 12, this is interpreted as a product by process claim, and as the process has been met, the product has been met as well.

#### ***Response to Arguments***

Applicant's arguments with respect to claims 11 and 12 have been considered but are moot in view of the new ground(s) of rejection.

5. Claims 9,10 , 11and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 8-77633 considered with Nakao et al and further or alternatively the JP document considered with Kubota et al ('747). That is the JP document considered with either of the secondary references.

JP 8-77633 (see the MAT (machine assisted translation of such), discloses a formatting system for optical discs in which the power level relied upon for formatting is less than that used for recording – see the MAT starting at paragraph 8.

There is no depiction of any calibration of the recording power.

Nakao et al, discloses in this environment, a calibration capability/process to optimize the system – see the entire description.

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It would have been obvious to modify the base system of JP 9-77633 with the above teaching from Nakao et al, motivation is to optimize the recording power value.

Alternatively, Kubota et al – see the description starting with the disclosure of figure 17 plus (9<sup>th</sup> embodiment), teaches in this environment, the ability of variable setting the power values to ensure proper overwriting. The examiner interprets such as the power calibration step of the independent step.

It would have been obvious to modify the base system of Jp 8-77633 with the above teaching from Kubota et al, motivation is to optimize the power level.

With respect to claims 10, and 12, these are interpreted as a product by process step. Such is met.

#### ***Response to Arguments***

Applicant's arguments filed 5/16/07 have been fully considered but they are not persuasive.

Applicant also argues that the base JP document is drawn to a magneto-optical system and because the claims are drawn to an optical system it is not germane to the problem. The examiner respectfully disagrees. Magneto-optical recording is a form of optical recording and those of ordinary skill in the art – as further supported by applicant's opening discussion with respect to such systems, are knowledgeable of such and would be drawn to such overlapping fields of recording for problem solutions.

Applicant then argues that because the base JP document relies upon a pre-stored value(s) for OPC, it does not necessarily follow that the same drive is used for the first and third steps as now recited.

This is not persuasive since while such is true, either secondary reference determines its optimized values in a system using the same drive. Secondary there is nothing in the base reference to prohibit the same drive being used in both the first formatting and subsequent formatting steps.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Hence the examiner maintains the grounds of rejections.

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**Conclusion**

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M. Psitos whose telephone number is (571) 272-7594. The examiner can normally be reached on M-F: 6:00 - 2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne D. Bost can be reached on (571) 272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Aristotelis M Psitos  
Primary Examiner

